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EXAMINER

GORT, ELAINE L

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AVRAM GLAZER

Appeal 2008-1755
Application 09/545,875
Technology Center 3600

Decided: July 21, 2008

Before WILLIAM F. PATE, III, LINDA E. HORNER, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Avram Glazer (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-14 and 44-50. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.¹

THE INVENTION

The claimed invention relates to providing a consistent and comprehensive approach to the use of banners as a source of access to information and services on networked computer system. (Specification 2:25 – 3:1.)

Claim 1, reproduced below, is representative of the subject matter on appeal.²

1. (Currently Amended) A method for providing multiple types of content for users of the Internet, comprising the steps of:

storing at least one file on at least one file server that provides Internet users with access to a plurality of different types of information and services;

establishing a connection between said file and at least one web page that is displayed at an Internet web site stored on a second server; and

causing at least some of the contents of said file to appear within a banner displayed within the web page at a communications device whenever the communications device, interfaced with the [first] file server and the second server, downloads said page for display.

¹ Our decision will refer to Appellant’s Appeal Brief (“App. Br.,” filed Feb. 23, 2006), Reply Brief (“Reply Br.,” filed Jul. 18, 2007), and the Examiner’s Answer (“Answer,” mailed May 18, 2007).

² The Examiner stated in the Answer that the claims in the appendix were correct. (Answer 3.) However, claim 1 in the appendix contains an error. The term “first” was replaced with the term “file” in the amendment of Nov. 18, 2004. As such, we have used claim 1 from this amendment to represent the subject matter on appeal.

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Wolfe	US 6,336,131 B1	Jan. 1, 2002
Getchius	US 6,496,843 B1	Dec. 17, 2002
Davis	US 6,643,696 B2	Nov. 4, 2003

THE REJECTIONS

The following rejections are before us for review:

Claims 1 and 44 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wolfe.

Claims 1-14 and 44-50 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfe and Davis in conjunction with the Examiner's position of Official Notice as evidenced by Getchius.

ISSUES

The first issue whether the Appellant has shown that the Examiner erred in rejecting claims 1 and 44 as anticipated by Wolfe. The second issue is whether the Appellant has shown that the Examiner erred in rejecting claims 1-14 and 44-50 as obvious with Wolfe and Davis. Both issues turn on whether Wolfe describes causing the contents of a file to appear within a banner displayed within a web page at a communications device whenever the communications device downloads the web page for display.

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

“Banner” is a specific term of art and has a specific definition understood by those skilled in the art.

1. The Appellant’s Specification discloses a “banner” is “a portion of a web page whose content is determined by a source which is separate from the source of the underlying content of the web page to which the browser has connected.” (Specification 2:1-4.)
2. Wolfe shows a “banner” 312 at the top of the web page 306 that is displayed on display 304, see figure 3. Wolfe describes the information within the banner could relate to another service provided by the publisher of the web page or advertisement space the publisher may wish to sell to a third party. (Wolfe, col. 4, ll. 55-65.)

Wolfe

3. Wolfe describes after requesting a web page over the network, a first window displays the web page. Concurrently displayed is a second window containing information related to the information displayed in the first window. (See e.g. Wolfe, Fig. 19 and col. 10, l. 60 to col. 11, l. 29.)

PRINCIPLES OF LAW

We determine the scope of the claims in patent applications not solely based on the claim language, but upon giving claims “their broadest reasonable interpretation consistent with the specification” and “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

It is well settled that in order for the examiner to establish a *prima facie* case of anticipation, each and every element of the claimed invention, arranged as required by the claim, must be found in a single prior art reference, either expressly or under the principles of inherency. *See generally, In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 677-78 (Fed. Cir. 1988); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 103(a), the examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *see also In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the appellant. *See Oetiker*, 977 F.2d at 1445; *see also Piasecki*, 745 F.2d at 1472. Obviousness is then determined based on the evidence as a whole and the relative persuasiveness of the arguments. *Id.*

ANALYSIS

Scope of the claims

The Appellant limits the claimed invention to displaying the contents of the file on the file server to a banner displayed within a web page (Claim 1). The Appellant contends Wolfe fails to describe the content of a file from the file server appearing “within any banner displayed within a web page, as recited in Appellant[’s] claim 1.” (Reply Br. 4) (emphasis omitted.) Given this argument, the claim language, the definition found within the Appellant’s Specification, and the evidence provided by Wolfe, we find the claimed invention requires displaying the information from the file server in a “banner” as that term is specifically understood by those of skill in the art. (Facts 1 and 2.)

35 U.S.C. § 102(e) rejection

In addition to contending the claimed invention is limited to displaying the contents of the file server within a banner, the Appellant contends that in Wolfe a separate window displays the information from the file server. (App. Br. 11-12 and Reply Br. 3.) We agree. (Fact 3.) The Examiner does not rely on Davis or Getchius for any teaching that would cure the deficiencies of Wolfe. As such, we will not sustain the Examiner’s rejection of claim 1 with Wolfe. Claim 44 depends from and further limits claim 1, and as such, Wolfe also does not anticipate claim 44.

35 U.S.C § 103(a) rejection

The Appellant contends Davis and Getchius fail to overcome the deficiencies of Wolfe for independent claim 1 and the dependent claims 2-14 and 44-50 further distinguish themselves from Wolfe. (App. Br. 12.) The

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Examiner does not rely on Davis or Getchius for any teaching that would cure the deficiencies of Wolfe, and thus dependent claims 2-14 and 44-50 are not obvious. As such, we will not sustain the Examiner's rejection of claims 1-14 and 44-50 with Wolfe, Davis, and Getchius used as evidence for the Examiner's position of Official Notice.

CONCLUSIONS OF LAW

We conclude that the Appellants have shown the Examiner erred in rejecting under 35 U.S.C. § 102(e) claims 1 and 44 with Wolfe and under 35 U.S.C. § 103(a) claims 1-14 and 44-50 with Wolfe, Davis, and Getchius.

DECISION

The Examiner's decision to reject claims 1-14 and 44-50 is reversed.

REVERSED

vsh

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